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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,250	12/09/2003	Michael Carter-Smith	P-6406-US	3360
27130	7590	12/14/2005		
EITAN, PEARL, LATZER & COHEN ZEDEK LLP 10 ROCKEFELLER PLAZA, SUITE 1001 NEW YORK, NY 10020			EXAMINER MENDOZA, MICHAEL G	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 12/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/730,250	Applicant(s) CARTER-SMITH ET AL.	
	Examiner Michael G. Mendoza	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-14 is/are rejected.
- 7) ☒ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

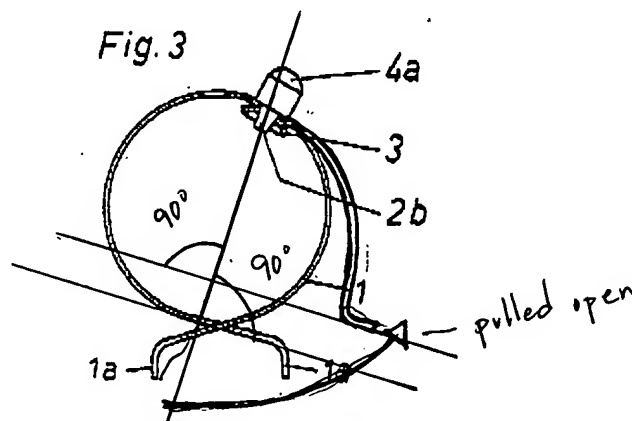
Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) .
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7 September 2005 have been fully considered but they are not persuasive. The applicant argues that Knetsch et al. does not teach "the projection extending inwardly from an inner surface of the acupressure ring, the projection being approximately orthogonal to a visual indication". The claim does not specify in what relationship the projection is orthogonal to the visual indication. In the figure below the visual indicator is shown to be in a plane. The projection is orthogonal to the plane of the visual indicator. Furthermore, the device of Knetsch et al. in use on a large digit as a thumb or on a larger part of the body such as the wrist can be opened by pulling on the visual indicator. Pulling the left 1a to the right while holding the other one 1a would also make the visual indicator orthogonal towards a 90 degree angle.



2. The Applicant has amended independent claim 1 adding new limitation changing the scope of the claim. The newly added limitation "wherein said visual indicator is provided by a break in the acupressure ring" requires new consideration and a new rejection. A new ground(s) of rejection is made in view of Yoo 6835174.

Art Unit: 3731

3. Applicant's arguments filed 7 September 2005 have been fully considered but they are not persuasive. In response to applicant's argument that the invention is an acupressure ring and Miller does not teach an acupressure, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The applicant also argues that Miller teaches away from the protrusion of claim 12 (actually in claim 11). The claim has the limitation of a shank that extends from 1.0 to 2.5 mm from the inner surface of the ring. Miller teaches the limitation and therefore reads on the claim.

Claim Objections

4. Claim 7 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependant claim. See MPEP § 608.01(n). Accordingly, the claim 7 not been further treated on the merits. Claim 7 can depend on claim 3, which is also a multiple dependant claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

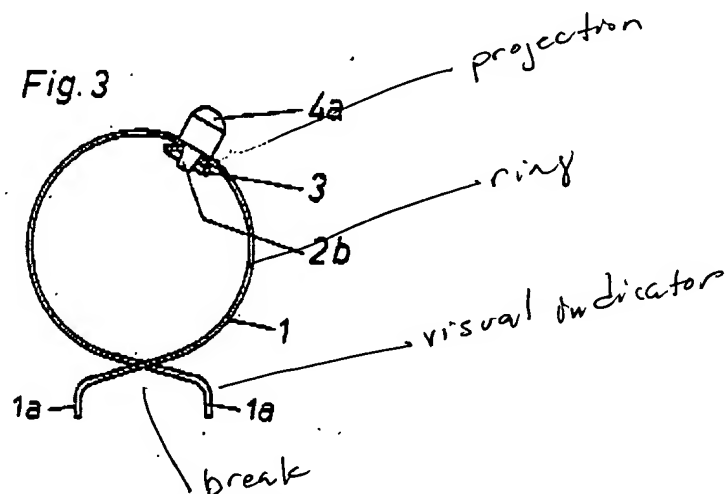
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

Art Unit: 3731

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Knetsch et al. 4122852.

7. Knetsch et al. teaches an acupressure ring for use on the outer finger, and comprising a ring having a visual indicator and a projection extending inwardly from the inner surface, the projection being approximately orthogonal to a visual indicator, wherein the visual indicator is provided by a break in the acupressure ring; the mid-point of the projection is approximately 90 degrees around the ring from the mid-point of the visual indicator; and the cross section of the projection is round, cylindrical, conical, square or rectangular (figs. 1-3).

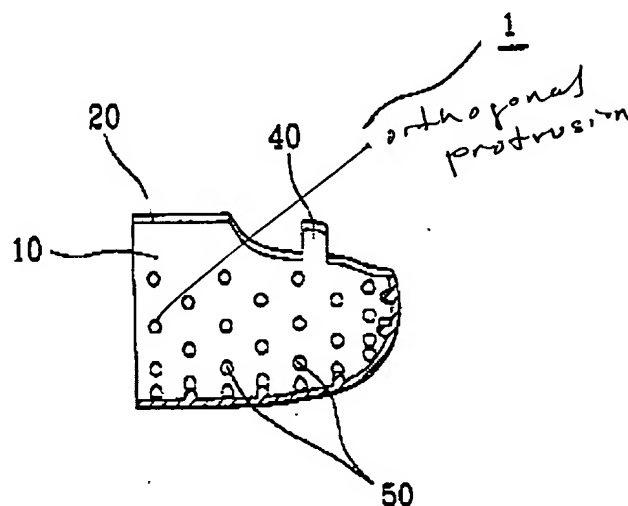
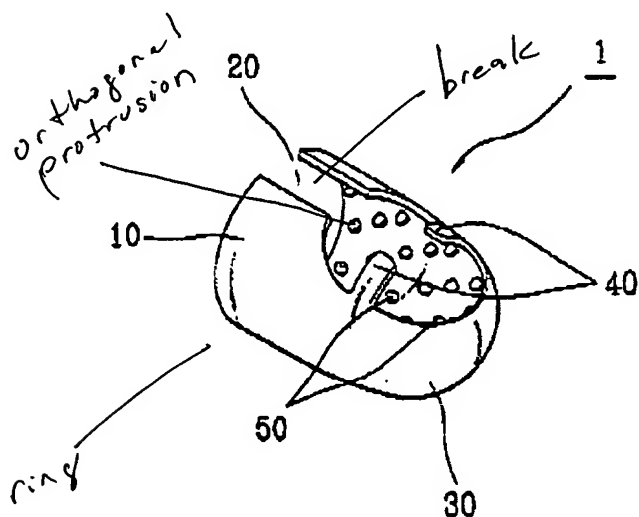


8. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoo 6835174.

9. You teaches an acupressure ring for use on the outer finger, and comprising a ring having a visual indicator visible when the ring is worn and a projection extending inwardly from an inner surface of the acupressure ring, the projection being approximately orthogonal to a visual indicator, wherein the visual indicator is provided

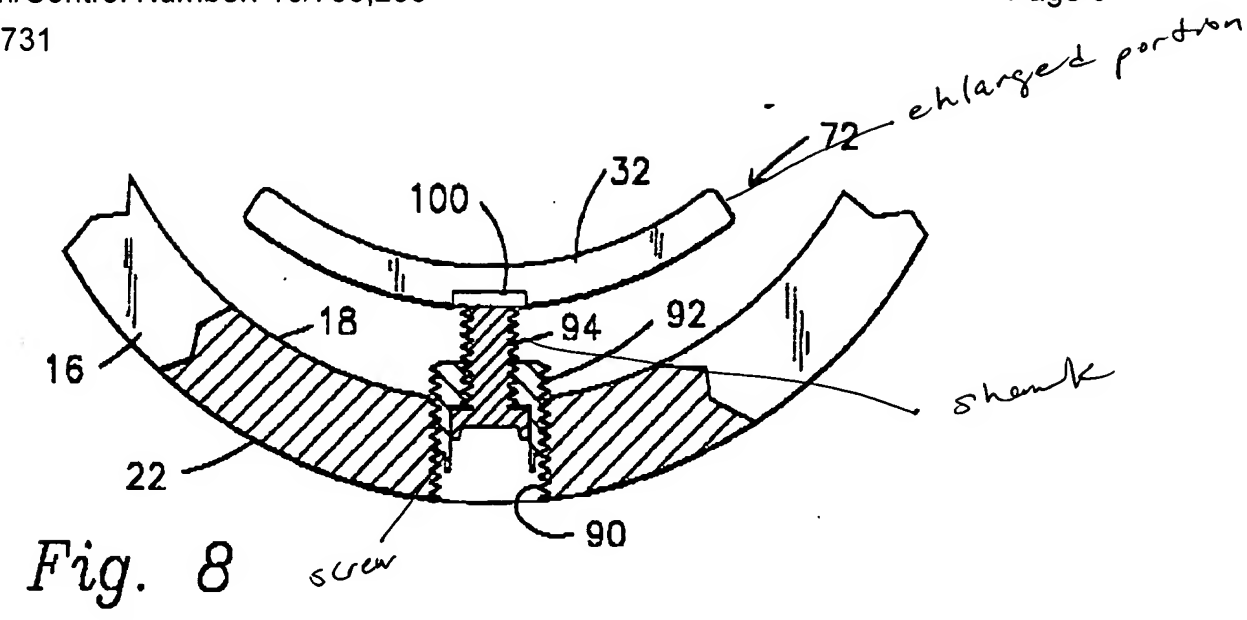
Art Unit: 3731

by a break in the acupressure ring; wherein the projection has a mid-point, which is approximately 90 degrees around the acupressure ring from the mid-point of the visual indicator; wherein the cross section of the projection is round, cylindrical, conical, square or rectangular.



10. Claims 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller 5636531.

11. Miller teaches an acupressure ring for use on the outer finger, and comprising a ring having a screw, the screw comprising a shank extending through the ring, the shank being attached at one end to a head portion and bearing a screw portion engaging with a corresponding screw extending through the ring; the shank has an enlarged portion at the end of the end remote from the head.



Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knetsch et al. or Yoo.

14. Knetsch and Yoo discloses the claimed invention except for the range of the projection extending from the inner surface is from 1 to 4 mm or from 1.6 to 2.0mm. It would have been obvious to one having ordinary skill in the art at the time the invention was to use the claimed ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Art Unit: 3731

15. Claims 11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller.

16. As to claims 11 and 14 Miller teaches a fully adjustable telescoping set screw (col. 6, line 64 – col. 7, line 10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the set screw adjustable to at least 2.5 mm into the ring to allow for adjust to a finger that is smaller in diameter to the actual diameter of the ring.

17. As to claim 13, Miller discloses the claimed invention except for the enlarged portion is removable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the enlarged portion removable, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Allowable Subject Matter

18. Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3731

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-44963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MM


GLENN K. DAWSON
PRIMARY EXAMINER